

11 MAY 2000



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#4

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In re Application of
HURTAK et al.
Application No.: 09/424,440
PCT No.: PCT/US98/10864
Int. Filing Date: 28 May 1998
Priority Date: 06 June 1997
Attorney's Docket No.: CRD0461
For: GLASS CORE GUIDEWIRE COMPATIBLE
WITH MAGNETIC RESONANCE HAVING
REINFORCING FIBERS

DECISION ON

PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to applicants' "PETITION UNDER 37 CFR 1.47" filed 28 February 2000.

BACKGROUND

On 28 May 1998, applicant filed international application PCT/US98/10864, which claimed priority of an earlier Netherlands application filed 06 June 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 December 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 December 1998, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 06 December 1999.

On 23 November 1999, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1); and two declaration each of which was signed by one of the three inventors.

On 19 January 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the

third inventor had not signed the declaration and that the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) was required. The notification set a one-month time limit in which to respond.

In order to satisfy the requirements of 35 U.S.C. 371(c)(4), applicants filed on 28 February 2000, accompanied by a certificate of mailing dated 22 February 2000, the following:

- 1) a petition under 37 CFR 1.47;
- 2) a letter from Cess Nap stating that "I have decided not to satisfy your request to sign the document";
- 3) a general power of attorney for several international applications filed under the Patent Cooperation Treaty signed by Cess Nap appointing Michael W. Montgomery to represent him before all competent International Authorities in connection with any and all international applications filed by the undersign with the following Office United States Patent and Trademark Office as receiving Office";
- 4) a purported in employment agreement in Dutch accompanied by a partial translation thereof.

DISCUSSION

Applicants response was due on 22 February 2000 since Monday 21 February 2000 was a Holiday. While the paper received on February 28, 2000 has on it a certificate of mailing dated 2-22-00, the paper also at the top left-hand corner has a facsimile imprint of FEB 23, 2000 6:31AM. Therefore, it would appear that the paper was not mailed on February 22, 2000 but on or after February 23, 2000. Accordingly, for the paper to be treated as timely, a one-month petition of time is necessary. Accordingly, a one-month petition fee of \$110 will be charged to applicants' account pursuant to 37 CFR 1.136(a)(3) as authorized in applicants' transmittal letter filed 23 November 1999.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. The petition is missing items (1), (2) and (3) above.

Regarding item (1) above, the petition fee was not offered with the petition. Accordingly, the petition fee will be charged to counsel's Deposit Account No. 10-0750 as authorized in the transmittal letter filed 23 November 1999.

Regarding item (2) above, applicant counsels states, " Messrs. Mous and Hurtak have properly signed the Declaration and Power of Attorney for the present application. Mr. Nap refused to sign the same document."

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. Mr. Montgomery statement does not state that a complete copy of the application papers was sent to the inventor. It would appear from his statement that only the declaration was presented to Mr. Hap.

Regarding item (3) above, a statement giving Mr. Hap last known address has been given.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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